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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823
24239	7590	03/03/2006	EXAMINER	
MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 03/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/792,038

Applicant(s)

RATH ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-59 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1,2 and 4-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

This is in response to papers filed on 24 January 2006.

I. The record shows that applicant elects the invention of Group I, claims 1-23 drawn compositions. The non-elected invention of Group II, claims 24-52 has been withdrawn from consideration.

II. Applicants further elects species of active cleaning combination of a quaternary base and at least one of an alkali metal and/or alkaline earth base species of claims 1-7 and 10. Accordingly, the non-elected species in claims 8-9 and 11-13 have been withdrawn from consideration.

III. The record shows that applicants filed Request for Continued Examination and a set of the amended claims on 24 January 2006. Accordingly, this Office action is made:

First: The elected a quaternary base and at least one of an alkali metal and/or alkaline earth base composition invention but not species as newly amended will be continued to be considered and examined as requested.

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Second: The non-elected a strong base and an oxidant composition but not species as newly amended.

Third: The newly added method claims 58-59.

In view of the amendment filed on 24 January 2006, additional restriction is made for the record as followed:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 1-2, 4-7, 10 and 53-57 drawn to a cleaning, removing and/or tripping composition containing a quaternary base and at least one of an alkali metal and/or alkaline earth base as the main chemical ingredients and possibly one or more additives, classified in photographic class 430 , subclass 256 and 331 and composition class 510, subclasses 175, 259, 391 and 504.
- B. Improper claims 8-9, 11-23 are improper as amended since it still depended on claim 1 (Claim 8 should be independent. Other should be depended on independent claim 8), drawn to a cleaning, removing and/or tripping composition containing a strong base and an oxidant as the main chemical ingredients and possibly one or more additives,

classified in photographic class 430 , subclass 256 and 331 and composition class 510, subclasses 175, 367 and 372.

- C. Claims 58-59, drawn to a cleaning, removing and/or stripping method, classified in class 134, subclass 2.

Inventions of Group A and B are all related to materials or compositions but are patentably distinct by their main chemical ingredients with respect to the distinct chemical structures and their function properties in the distinct fields of searches. There is no evidence on and for the record that they are not patentably distinct and are obvious and stand or fall together. Applicants should show or provide a convincing evidence for the record. In the absence of convincing evidence on and for the record, the restriction on the record would not be removed.

Inventions of Groups (A and B) and Group C are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case, the product as claimed can be used in a material different process such table top cleaning, machine dishwashing, drain cleaning, metal oxidizing. Applicants should show or provide a convincing evidence to the contrary. In the absence of such evidence, the restriction on the record would not be removed.

There is no evidence on the record that they are not patentably distinct. Therefore, no separate consideration or search is required. They are stood or fall together. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and can support separate patent as divided by applicants, restriction for examination purposes as indicated is proper.

IV. Applicant is advised that the invention of Group C, claims 1-2, 4-7, 10 and 53-57 will be continued to be reconsidered and researched but as a new after applicants filed Request for Continued Examination on 24 January 2006 as required, especially with one or more amended and/or added embodiments and/or claim(s) to the set of the claims. However, applicants may change their mind to elect and request to consider, search and examine one of other inventions. Then an

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additional election of species and/or restriction may be additionally made in accordance to the new election and request.

V. This Office action is mainly and early made for the record of the restriction of the compositions as amended. It is also given applicants' opportunity to respond the restriction for the record in an early state of a prosecution as a new after filed Request for Continued Examination on 24 January 2006 as required.

VI. However, a method claim is permitted to be rejoined with an allowable (material (composition)) claim. If the method claim contains all of the limitations of the material claim when the material is firstly elected, considered, searched, examined and found to be allowable.

VII. No other issue is considered until a proper and complete response to the restriction on the record is made and resolved.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

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The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 February 2006

HOA VAN LE
PRIMARY EXAMINER
